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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,703	12/13/1999	Kiran A. Padwekar	884.027US1	1539

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EXAMINER	
MEONSKE, TONIA L	
ART UNIT	**PAPER NUMBER**
2183	

DATE MAILED: 06/30/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/459,703	PADWEKAR, KIRAN A.
	Examiner	Art Unit
	Tonia L Meonske	2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8, 10, 11, 14-20, 22, and 23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Deao et al., US Patent 6,065,106.

3. The rejections are respectfully maintained and incorporated by reference as set forth in paper number 13, mailed on September 4, 2002.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 9, 12, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deao et al., US Patent 6,065,106.

6. The rejections are respectfully maintained and incorporated by reference as set forth in paper number 13, mailed on September 4, 2002.

Response to Arguments

7. Applicant's arguments filed April 15, 2004 have been fully considered but they are not persuasive.

8. On pages 7 and 8 Applicant argues in essence:

"The claimed replay handler is altogether different from Deao's sequence of emulation-event triggered debug instructions. Although the replay handler requires an initial replay break to begin execution, the replay handler does not require another replay break or emulation event to execute the replay handler again. "The replay handler may have a predetermined number of replays for each execution." Specification at page 7, lines 21-23. That is. The claimed replay handler will repeatedly execute as many times as were predetermined before the replay break. Because the claimed replay handler will repeatedly execute without another emulation event, Deao does not teach a replay handler, as recited in the rejected claims."

However, claimed subject matter, not the specification, is the measure of invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Self*, 213 USPQ 1,5 (CCPA 1982); *In re Priest*, 199 USPQ 11,15 (CCPA 1978). In this case, Applicant is arguing that which is not claimed, i.e. "the replay handler will repeatedly execute as many times as were predetermined before the break without another emulation event". If Applicant would like specific limitations read into the claims, then Applicant should specifically claims those limitations. Therefore this argument is moot.

9. On page 8, Applicant argues in essence:

"Applicant respectfully disagrees and submits that the office action had mischaracterized a multi-word register as being part of the memory hierarchy. "The memory hierarchy 102 can be an amount of dynamic ram, cache memory, a linear array, or virtual memory." Specification at page 4, lines 12-13. However, registers (which are not DRAM, cache memory, linear array or virtual memory) are not part of the memory hierarchy."

However, registers are necessarily a part of the overall memory hierarchy. For support see Hennessey et al., Computer Architecture A Quantative Approach, Second Edition, pages 39-41. Figure 1.15 shows that registers are in fact part of the memory hierarchy. Therefore this argument is moot

10. On page 10, Applicant argues in essence:

> *"Because the rejection under 35 USC 103 does not provide any teaching or suggestion about how one of ordinary skill in the art would modify Deao to make the claimed invention, Applicant respectfully submits that dependent claims 9, 12, 13 and 21 are patentable over Deao for at least the reasons given above, with reference to claims 6, 10, and 20."*

However, it is not on the burden of the Examiner to provide the implementation details on how to specifically combine concepts. Merely having the motivation to combine known concepts is all that is necessary. In the case of claim 9, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system, as taught by Deao et al., have the storage element be a hard drive so that a greater amount of state information could be stored and the information would not be lost when power is absent. Therefore this argument is moot.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonia L Meonske whose telephone number is (703) 305-3993. The examiner can normally be reached on Monday-Friday, 8-4:30.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie P Chan can be reached on (703) 305-9712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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